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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/274,781	03/24/1999	HERBERT PEIFFER	07456.0009	8886

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FINNEGAN HENDERSON FARABOW
GARRETT & DUNNER
1300 I STREET N W
WASHINGTON, DC 200363615

EXAMINER

CHEN, VIVIAN

ART UNIT	PAPER NUMBER
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1773

15

DATE MAILED: 02/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

A9-16

Office Action Summary

Application No.
09/274,781

Applicant(s)
PEIFFER et al

Examiner
Vivian Chen

Art Unit
1773



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12-3-01.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-23 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

1. Claim 7 has been cancelled by Applicant.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-6, 8-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,054,212 (PEIFFER ET AL) in view of KIMURA ET AL (US 5,747,174) for the reasons expressed in the previous Office Action.

U.S. Patent No. 6,054,212 (PEIFFER ET AL) claims multilayer polyester films as recited in Application 09/274781 claims 1-13, 15-17. However, the patent does not explicitly claim films with the recited functional coatings or surface tension.

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KIMURA ET AL discloses that it is well known in the art to surface treat multilayer polyester film such that the film has a surface tension of not less than 40 dynes/cm (lines 54-68, col. 8) prior to application of a functional coating such as an metal oxide or polymeric barrier layer and adhesion promoting layers (lines 31-53, col. 6) in order to obtain films with strongly adhered coatings, wherein the film is suitable for packaging, printing and other conventional applications using polyester film as recited in Application 09/274781 claims 1, 14-15, 18, 21-23.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply a functional coating to the film claimed in U.S. Patent No. 6,054,212 (PEIFFER ET AL) and to adjust the thickness of said functional coating as indicated in claims 1, 15 depending on the type of coating material and the desired physical property. It is well known in the art to use polyester films as substrates in printing, packaging, and photographic applications as indicated in claims 18-23.

Response to Amendments

4. The rejections under 35 USC 103(a), in paragraph 4 of the previous Office Action have been withdrawn in view of Applicant's amendments regarding the outer layer thickness.

Response to Arguments

5. Applicant's arguments filed 12/3/2001 have been fully considered but they are not persuasive.

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(A) Applicant argues that there is no motivation to combine the known coatings such as those disclosed in KIMURA ET AL with the films as claimed in U.S. Patent No. 6,054,212 (PEIFFER ET AL). However, despite Applicant's contentions to the contrary, it is both conventional and well known in the art to apply performance enhancing coatings to polymeric films in order to optimize the physical properties of the film for use in various applications. Since the particular type of functional coating used on a polyester film is a matter of readily ascertained design choice dictated by the specific mechanical, surface, optical, electrical, and/or adhesive properties desired for a given end use, it is the Examiner's position that it becomes Applicant's burden to provide probative and convincing evidence that one of ordinary skill in the art would *not* be motivated to apply the types of conventional functional coatings such as those disclosed in KIMURA.

(B) Applicant argues that there is no motivation to use the barrier coatings in KIMURA ET AL on the films claimed in U.S. Patent No. 6,054,212 (PEIFFER ET AL) because the claimed films already have very good oxygen barrier properties. However, the mere fact that a substrate film has good barrier properties by itself does not automatically deter one of ordinary skill in the art from seeking to increase said barrier properties even further with the application of additional conventional barrier layers, especially when such barrier properties are deemed critical for a given application (i.e., packaging of particularly sensitive chemicals or foodstuffs, etc.). Furthermore, metal and oxide layers not only are desirable for improving barrier properties, but are also commonly used to obtain specific optical and/or decorative effects.

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(C) Applicant argues that KIMURA ET AL fails to disclose or suggest the claimed functional coatings because the reference only teaches the use of 150 nm thick metal layers. As an initial matter, it must be noted that most of the present claims only require a film surface having a specified surface tension *or* a functional layer of the specified thickness, not both. Since the reference clearly discloses the desirability of treating a film surface to achieve a particular surface tension, the thickness of the functional layer would be irrelevant. Furthermore, the teachings of a reference are not strictly and solely limited to the specific values mentioned in the reference's examples, especially since there is no indication in KIMURA ET AL that a metal layer thickness of 150 μm is somehow critical. It is the Examiner's position that one of ordinary skill in the art would have readily adjusted the thickness of a metal or metal oxide layer applied to a polyester film in order to obtain the necessary barrier and/or optical and/or decorative properties for a specific usage. Applicant has not provided any probative evidence to the contrary, nor has Applicant provided any probative evidence to indicate that the functional layer thickness recited in the claims is critical or provided unexpected results.

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Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (703) 305-3551. The examiner can normally be reached on Monday-Thursday from 8:30 AM to 6:00 PM and on alternate Fridays from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Paul Thibodeau, can be reached on (703) 308-2367.


For Art Unit 1773, the official fax phone numbers are as follows:

before Final: (703) 872-0310

after Final: (703) 305-7718

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1700 receptionist whose telephone number is (703) 308-0661.

VC
February 8, 2002


Vivian Chen
Primary Examiner
Group 1700